



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,384	02/06/2004	John L. Marcantonio	MS1-1833US	6338
22801	7590	08/21/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			HINZE, LEO T	
			ART UNIT	PAPER NUMBER

2854

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/773,384	MARCANTONIO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Leo T. Hinze	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040206</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2854

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 1-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12 June 2006.

2. Applicant's election with traverse of claims 28-33 in the reply filed on 12 June 2006 is acknowledged. The traversal is on the ground(s) that separate searches would not be needed for the claims in the separate groupings. This is not found persuasive because separate searches would be needed: for example, the search for the invention claimed in claims 28-33 would encompass art classified in class 368; the search for the invention claimed in claims 28-33 would encompass art classified in class 709.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2854

4. Claims 28, 32 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Herron et al., US 6,791,904 B1 (hereafter Herron).

a. Regarding claim 28, Herron teaches a clock radio comprising: an electronic time base to keep time (Herron inherently has a time base, as the clock radio keeps a clock time, col. 4, l. 43, and a user can set alarm times, col. 4, l. 47); a display device (“digital display,” col. 4, ll. 45-46) to display the time; a control panel (“tactile controls on the clock-radio device,” col. 4, ll. 33-34) configured to receive local instructions, including local time set instructions and local alarm set instructions; a communication interface (“telephone jack,” col. 2, l. 24; other interfaces, col. 9, ll. 53-56) configured to receive remote instructions, including remote time set instructions, remote alarm set instructions, and a remote audio data stream from a network device; and a control module (Herron inherently has a control module, as the user is able to set the time and set an alarm, col. 4, ll. 42-49) configured to set the time, to set an alarm, and to render the remote audio data stream in accordance with the local instructions and the remote instructions.

b. Regarding claim 32, Herron teaches all that is claimed as discussed in the rejection of claim 28 above. Herron also teaches wherein the remote audio data stream comprises a preconfigured playlist of audio files (“subscriber selects audio content,” col. 3, ll. 64-65).

c. Regarding claim 33, Herron teaches all that is claimed as discussed in the rejection of claim 32 above. Herron also teaches wherein the audio files are selected from the group comprising: a news audio file representing a text-based news story translated by a text-to-speech engine; a weather audio file representing a text-based weather report translated by a text-to-speech engine; a business audio file representing a text-based business story translated by a text-

Art Unit: 2854

to-speech engine; a sports audio file representing a text-based sports story translated by a text-to-speech engine; a traffic audio file representing a text-based traffic report translated by a text-to-speech engine (see list in col. 4, ll. 7-15).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron in view of Janik, US 2005/00113946 A9 (hereafter Janik).

a. Regarding claim 29:

Herron teaches all that is claimed as discussed in the rejection of claim 28 above.

Art Unit: 2854

Herron does not teach wherein the control panel comprises: a forward button configured to skip forward to a next audio file in the remote audio data stream; a back button configured to skip backward to a previous audio file in the remote audio data stream; and an audio source button configured to skip between a plurality of audio data sources available from the network device.

Janik teaches an audio converter device with the ability to stream audio from sources on the internet (§ 12), including an interface device (32, Fig. 2) with remote (148, Fig. 6), having a track forward button (108, Fig. 6), a track backward button (112, Fig. 6), and a menu button (152, Fig. 6). The system has the ability to play MP3 digital audio files (§ 6).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Herron to include forward, backward, and source controls as taught by Janik, because a person having ordinary skill in the art would recognize that this would allow a user to be able to chose to move forward, backward and change the audio program, thereby allowing the use to, for example, replay an important audio file containing traffic or weather information which she may not have clearly heard the first time.

b. Regarding claim 30, the combination of Herron and Janik teaches all that is claimed as discussed in the rejection of claim 29 above. Herron also teaches wherein the control panel further comprises: a snooze button to turn off the alarm temporarily (“snooze,” col. 4, l. 41); a stop/resume button to alternately stop and resume a local function (“playing audio playback is interrupted with the new audio playback,” col. 6, ll. 41-58); a local function button to alternately

Art Unit: 2854

set the clock radio to different local functions (col. 6, ll. 41-58); and a volume button to set a volume level for the clock radio ("set volume," col. 4, l. 41).

c. Regarding claim 31, the combination of Herron and Janik teaches all that is claimed as discussed in the rejection of claim 30 above. Herron also teaches wherein the local functions are selected from the group comprising: a time set function (col. 4, l. 42); an alarm set function (col. 4, l. 42); an AM radio station function (col. 4, l. 42); an FM radio station function (col. 4, l. 42); and an audio source function (col. 6, ll. 41-58).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leo T. Hinze  
Patent Examiner  
AU 2854  
11 August 2006



Daniel J. Colilla  
Primary Examiner  
Art Unit 2854